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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,177	10/31/2003	Rex Wesley Shores	31849.42	9899
J. Andrew Lowes HAYNES AND BOONE, LLP Suite 3100 901 Main Street Dallas, TX 75202-3789			EXAMINER CUMBERLEDGE, JERRY L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 11/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,177

Applicant(s)

SHORES ET AL.

Examiner

JERRY CUMBERLEDGE

Art Unit

3733

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56-58 is/are allowed.
- 6) ☒ Claim(s) 39, 40, 45-49, 53 and 54 is/are rejected.
- 7) ☒ Claim(s) 41-44, 50-52 and 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39, 40, 45, 46, 48, 49, 53 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Trott (US Pat. 5,851,208).

Trott discloses a surgical instrument for the dissection of bone or other tissue having a motor with a power output, the surgical instrument comprising: a dissection tool (Fig. 1, ref. 30) having an elongated shaft (Fig. 1, ref. 39), a proximal end (Fig. 1, near ref. 34), and a distal end (Fig. 1, near ref. 36); a coupling assembly (Fig. 1, ref. 34) for coupling the power output to the proximal end of the dissection tool (Fig. 1), the coupling assembly extending along a longitudinal axis (Fig. 1); and an attachment tube (Fig. 1, ref. 20) having a proximal portion (Fig. 1, ref. 24) movably coupled to the coupling assembly and an internal passage extending from the proximal portion to an opposite distal portion (Fig. 1, near ref. 44), the proximal portion of the internal passage extending substantially along the longitudinal axis (Fig. 1) and the distal portion of the internal passage extending at an oblique angle with respect to the longitudinal axis (Fig. 1, near ref. 42); wherein the attachment tube is movable along the longitudinal axis between a first coupled position and a second coupled position with respect to the coupling assembly (Fig. 1) such that the distal end of the dissection tool extends beyond

the distal portion of the attachment tube a first distance in the first coupled position and the distal end of the dissection tool extends beyond the distal portion of the attachment tube a second distance in the second coupled position (Fig. 1), wherein the second distance is greater than the first distance (Fig. 1). The attachment tube is couplable to the coupling assembly at a plurality of locations along the longitudinal axis with respect to the coupling assembly (Fig. 1). The attachment tube further comprises at least one bearing in the proximal portion and at least one bearing in the distal portion, each of the bearings supporting at least a portion of the elongated shaft (Fig. 6, e.g. bearing surfaces of ref. 50 which engage ref. 20). The attachment tube further comprises a curved transition portion connecting the proximal portion of the attachment tube to the distal portion of the attachment tube (Fig. 1, above ref. 42).

Trott discloses a surgical instrument for the dissection of bone or other tissue having a motor with a power output, the surgical instrument comprising: a dissection tool (Fig. 1, ref. 30) having an elongated shaft (Fig. 1, ref. 39), a coupling area adjacent a proximal portion (Fig. 1, near ref. 34), and a dissecting area adjacent a distal portion (Fig. 1, ref. 26); a coupling assembly (Fig. 1, ref. 34) for fixedly coupling the power output to the coupling area of the dissection tool, the coupling assembly extending along a longitudinal axis (Fig. 1, ref. 34); an attachment tube movably coupled to the coupling assembly (Fig. 1, ref. 20), the attachment tube receiving and supporting at least a portion of the elongated shaft (Fig. 6, e.g. bearing surfaces of ref. 50 which engage ref. 20), a proximal portion of the attachment tube extending substantially along the longitudinal axis (Fig. 1, near ref. 46) and a distal portion of the tube extending along

an axis extending at an oblique angle with respect to the longitudinal axis (Fig. 1, near ref. 42), a curved transition portion (Fig. 1, above ref. 42) connecting the proximal portion to the distal portion; wherein the attachment tube is movable along the longitudinal axis with respect to the coupling assembly between a first coupled position and a second coupled position (Fig. 1); wherein in the first coupled position the elongated shaft of the dissection tool includes a bend corresponding to the curved transition portion of the attachment tube at a first distance from the dissecting area (Fig. 1)(Fig. 6); and wherein in the second coupled position the elongated shaft of the dissection tool includes a bend corresponding to the curved transition portion of the attachment tube at a second distance from the dissecting area, the second distance being less than the first distance (Fig. 1)(Fig. 6). The attachment tube is couplable to the coupling assembly at a plurality of locations along the longitudinal axis (Fig. 1)(Fig. 6). The motor includes a motor housing and the coupling assembly is removably coupled to the motor housing (column 1, lines 5-6)(Fig. 1)(Fig. 6). The attachment tube further comprises at least one bearing in the proximal portion and at least one bearing in the distal portion, each of the bearings supporting at least a portion of the elongated shaft (Fig. 6, e.g. bearing surfaces of ref. 50 which engage ref. 20).

With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over the device of Trott, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the

subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trott (US Pat. 5,851,208).

Trott discloses the claimed invention except for the oblique angle being between about 3° and about 30° with respect to the longitudinal axis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the device of Trott with the oblique angle being between about 3° and about 30° with respect to the longitudinal axis, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 56-58 are allowed.

Claims 41-44, 50-52 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY CUMBERLEDGE whose telephone number is (571)272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C./
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733